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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,122	02/17/2004	Christopher E. Fischer	2034	6476

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EXAMINER

MAZUMDAR, SONYA

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,122

Applicant(s)

FISCHER ET AL.

Examiner

Sonya Mazumdar

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 22-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 1 through 9 and 22 through 42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected article, transfer pattern, and method of forming a transfer pattern, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 19, 2005.

Claim Rejections - 35 USC § 112

2. Claims 17 and 18 contain the trademark and trade name Scotchlite Transfer Film and 3M Corporation. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to describe a combination of said substrate and said first pigmented material in claim 17 and said first pigmented material in claim 18 and, accordingly, the identification is indefinite.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1734

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10 through 15 and 19 through 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Saegusa et al. (US 5921449) in view of Olsen (US 5916399).

With respect to claim 10, Saegusa et al. discloses a method to form a spare tire cover to extend over a tire completely (column 1, lines 44-46), which includes forming a material in the shape of a tire cover comprising a cylindrical panel extending around the tread surface of the tire (column 2, lines 60-63) and a face panel with a display surface connected to the cylindrical panel (column 2, lines 63-65; column 3, lines 64-67).

However, Saegusa et al. does not disclose the step of contacting the display surface with a transfer pattern. Olsen teaches a method for forming retroreflective graphic images on a surface (column 1, lines 8-11). The graphic images are formed via contact between a transfer sheet material and a substrate (column 2, lines 14-17). The transfer sheet material contains the following components: a base sheet with a heat-softenable layer (column 3, lines 28-32), a monolayer of microspheres attached to a color layer in an imagewise pattern, a reflective layer in a second imagewise pattern, and a bonding layer embedding over all exposed surfaces (column 2, lines 17-36; Figure 1). The transparent microspheres are made of glass (column 3, lines 43-44). The bonding layer penetrates the fabric and attaches the design to the fabric. This layer is formed by printing a bonding composition in an imagewise manner over both the color and the reflective layers. The bonding composition is printed in an amount

Art Unit: 1734

which is at least sufficient to embed all exposed surfaces of the color layer and the reflective layer (column 6, lines 23-31).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used this transfer pattern to make an image on the sidewall panel of the tire cover. One would have been motivated to do so because the graphic images produced are used for multi-colored emblems or designs and could be potentially used for safety procedures (column 6, lines 8-11).

With respect to claim 11, Saegusa et al. discloses the step of forming including molding a vinyl material in the shape of a tire cover (column 1, line 15).

With respect to claim 12, Saegusa et al. discloses sewing sheets as the face panel to form the spare tire cover (column 3, lines 21-22).

With respect to claim 13, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches that the second pigmented material in the transfer pattern has retroreflective properties. The graphic segments in the layers, which are both colored and retroreflective, can be illuminated with a light beam which brilliantly retroreflects in the color of the underlying graphic design (column 8, lines 30-32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have prepared the second pigmented material in the transfer pattern to have retroreflective properties. One would have been motivated to do so because the color layer filters the light rays as they pass through the colorant of the

Art Unit: 1734

color layer, and the filter action produces a color hue in these light rays (column 8, lines 35-38).

With respect to claim 14, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches that the second pigmented material in the transfer pattern has does not have retroreflective properties. The layer contains pigment or dye and a transparent resin (column 4, nlines 30-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have prepared the second pigmented material in the transfer pattern to not have retroreflective properties. One would have been motivated to do so because increasing the proportion of colorant tends to deepen the colors produced (column 8, lines 38-40).

With respect to claim 15, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the use of different colored pigmented materials in the transfer pattern. If two differently colored colorant compositions are printed in layers that do not overlap, the layers contribute to a multi-colored design (column 4, lines 22-24). If layers are overlapped, an additive color is achieved (column 4, lines 24-26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used different colored pigmented materials in the transfer pattern. One would have been motivated to do so because the graphic designs and

Art Unit: 1734

images produced are multi-colored or of a unique additive color (column 4, lines 13-15).

With respect to claim 19, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the use of a hot-melt adhesive in the bonding layer of the transfer pattern. The bonding composition has a hot-melt adhesive powder fused into the resin of the layer (column 6, lines 35-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a hot-melt adhesive in the transfer pattern. One would have been motivated to do so because the hot-melt adhesive powder can be applied in any suitable technique known in the art and promotes the bonding of the transfer sheet to the substrate (column 6, lines 60-62; column 7, lines 4-5).

With respect to claim 20, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the application of pressure when contacting the transfer pattern and the display surface. A pressure-sensitive adhesive could be used as the adhesive in the bonding layer and still retain an imagewise pattern through transfer (column 8, lines 50-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied pressure when contacting the transfer pattern and the display surface. One would have been motivated to do so because applying pressure where the transfer pattern includes a pressure-sensitive adhesive would

Art Unit: 1734

avoid the use of heating to form the contact between the transfer pattern and display surface (column 8, lines 53-54).

With respect to claim 21, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the application of heat when contacting the transfer pattern and the display surface. The transfer is accomplished by laying the pattern against the substrate surface and then placing the assembly in a heat-transfer machine set (column 8, lines 7-9). During this time, the bonding layer softens to penetrate into the substrate through openings in the substrate surface (column 8, lines 13-14). The assembly is then permitted to cool so that the bonding layer exhibits a strong adhesion to bond the transferred emblem to the substrate (column 8, lines 15-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used heat when contacting the transfer pattern and the display surface. One would have been motivated to do so because using heat creates a strong adhesive bond between non-woven materials (column 8, lines 3-6).

Allowable Subject Matter

5. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on Mon-Fri, 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SM


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Au 1734